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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,382	12/29/2000	Jon M. Bishay	33734-8004US1	7499

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 04/01/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Office Action Summary

Application No.

09/751,382

Applicant(s)

BISHAY ET AL.

Examiner

George R Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8, 23, 24, 28, 29, 33, 36-40, 42-63, 65-75, 77-84, 87-92 and 131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29, 77-82 and 88 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 52, 55, 60, 67, 72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims rejected are 2-6,8,23,24,28,33,36-40,42-51,53,54,56-59,61-63,65,66,68-71,73-75,83,84,87,89-92 and 131.

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 2/28/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Since the IDS is very large, it is suggested to have someone hand carry the IDS to the examiner so the IDS does not get lost.

### ***Response to Amendment***

The finality of the rejection of the last Office action has been withdrawn due to new art being found and applied to the claims. The amendment after final submitted 2/28/03 has been entered and the following action is given below for the entered amendment.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-6, 8, <sup>7</sup>13, 23, 24, 28, 32, 33, 36, 38-40, 42-44, 47, 49, 53, 54, 58, 61-63, 65, 66, 70, 83, 87, 89, 91, 92 and 131 are rejected under 35 U.S.C. 102(b) as being anticipated by Varelis et al. (5033474). Varelis is capable of meeting the functional use recitations presented in the claim. Varelis's system uses a laptop ("configured to rest on a body") and uses hooks, clips,

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and snap type fasteners, ("configured to be coupled to a percutaneous probe"). In addition, "cavity" is a broad term and met by Varelis since he uses holes, hollows, deeply indented or concave areas, etc. on the support member or engagement member.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 84 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Varelis et al. since Varelis uses a personal laptop computer, his system will inherently carry a source of electrical current.

In the alternative, Varelis discloses the claimed invention except for the health unit carrying a source of electrical current. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the health unit as taught by Varelis, with the unit carrying a source of electrical current since it was known in the art that personal laptop

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computers carry a source of electrical current to allow the unit to operate in areas where electricity is not readily available.

Claims 37, 45, 46, 48, 50, 51, 56, 57, 59, 68, 69, 71, 73-75, 83, and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varelis et al.

Varelis discloses the claimed invention and being able to use different fasteners for the cables except for the support member being flexible, biocompatible, and resilient to conform to a surface of the body (claims 37, 48, and 90), the engagement members having different colors or visual indicators (claims 45 and 46), the first coupler including a conductive clamp or alligator clip (claims 50, 51, 56, 57, 68, and 69), and the cables being different lengths (claims 59 and 71). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the health system as taught by Varelis, with the support member being flexible, biocompatible, and resilient to conform to a surface of the body, the first coupler including a conductive clamp or alligator clip, and the cables being different lengths, since it was known in the art that health systems use: support members that are flexible, biocompatible, and resilient to conform to a surface of the body, the cables being different lengths, to provide a comfortable support member that does not irritate the patient; the engagement members having different colors or visual indicators to prevent a mix-up of electrodes or cables and to show where electrodes or cables should be attached to the patient; the first coupler including a conductive clamp or alligator clip to provide an equivalent alternative fastener to allow the parts to be quickly and easily connected and disconnected; and cables that are different lengths to allow the electrodes to reach places on the patient at a distance further from other electrodes that do not require that distance.

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***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

Claims 29, 77-82, and 88 are allowed.

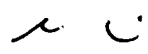
Claims 52, 55, 60, 67, and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

  
George R Evanisko  
Primary Examiner  
Art Unit 3762

3/25/3

GRE  
March 25, 2003